

Appl. No. 10/688,118
Atty. Docket No. 9066M2
Reply to Office Action of 07/21/06
Customer No. 27752

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REMARKS

Claim Status

Claims 1-20 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC §103(a) Over WO 02/48458 in View of U.S. 3,624,019

Claims 1-20 stand rejected under 35 U.S.C. §103(a) over Barnholtz et al (WO 02/48458 – hereinafter “Barnholtz”) in view of Anderson (U.S. 3,624,019 – hereinafter “Anderson”). The Applicant respectfully traverses this rejection. The combination does not render the present claims obvious under 35 U.S.C. §103(a) because Barnholtz in view of Anderson does not teach or suggest every limitation as claimed by the Applicants, nor does Barnholtz in view of Anderson provide one of ordinary skill in the art with a reasonable expectation of success of obtaining the claimed invention. MPEP §2142, §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

One of ordinary skill in the art would not have a reasonable expectation of success of arriving at the claimed invention by combining the teachings of Anderson and Barnholtz. Anderson only teaches inverting the water-in-oil polymer emulsions into water with surfactant (Anderson, col. 3, lines 70-75 – col. 4, lines 1-14). The Applicant, in a declaration under 37 C.F.R. §1.132, points out that Barnholtz teaches an oil-in-water softening composition, but Anderson makes no mention of inverting the water-in-oil polymer emulsion into anything other than aqueous media and that one of ordinary skill in the art would not understand Anderson to teach the inversion of water-in-oil emulsions into an oil-in-water emulsion. (Declaration, p. 2). It is well established that in order to combine prior art references, there must be a suggestion, teaching, or motivation to do so, *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), and that it is improper to combine references merely by supplying a suggestion of “skill in the art.” *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

In addition, one of ordinary skill in the art would not expect the water-in-oil emulsion taught in Anderson to invert in the oil-in-water emulsion taught in Barnholtz. The Applicant, in a declaration under 37 C.F.R. §1.132, refers to a the “Miller” publication (Miller, D. J.; Henning, T.; Grunbein, W; Phase inversion of W/O emulsions by adding hydrophilic surfactant – a technique for making cosmetic products, *Colloids and Surfaces A: Physicochemical and Engineering Aspects*, Volumes 183-185, 15 July 2001, pp. 681-688) as evidence that phase inversion is known to those of ordinary skill in the art to require certain critical quantities of water

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to be added to the emulsion, but the oil present in the oil-in-water emulsion taught by Barnholtz would lead one of ordinary skill in the art to expect no inversion of Anderson's water-in-oil emulsion. (Declaration, p. 2) Thus, one of ordinary skill in the art would not have a reasonable expectation of success of combining the teachings of Anderson with the teachings in Barnholtz because Barnholtz teaches a much lower water concentration as compared to Anderson.

Further, Anderson teaches that polymers can be used in solution for their "thickening and flocculating properties." (Anderson, col. 1, line 6). However, Barnholtz discloses that "compositions having a high viscosity are difficult to apply to tissue webs for softening purposes." (Barnholtz, p. 20, lines 30-34). Thus, one of ordinary skill in the art would not have a reasonable expectation of arriving at the claimed invention by combining the water-in-oil emulsion taught by Anderson with the invention taught by Barnholtz because Barnholtz specifically states that a high viscosity is undesirable for the purposes of that invention and the water-in-oil emulsion of Anderson contains polymers that are said to have a thickening quality in solutions.

Therefore, Barnholtz in view of Anderson does not teach or suggest every limitation as is claimed by the Applicant. Further, Barnholtz in view of Anderson does not provide one of ordinary skill in the art with a reasonable expectation of success of arriving at the claimed invention. As a result, the obviousness rejection is improper and should be withdrawn.

Conclusion

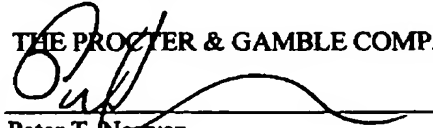
In light of the above remarks, it is requested that the Examiner reconsider the application. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, and allowance of Claims 1-20 is respectfully requested.

Respectfully submitted,

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